



**PATENTS ACT 1977**

WallJam Limited and  
IEE International Electronics & Engineering S.A.

Claimants

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**PROCEEDINGS**

Reference under section 12(1)(a) of the Patents Act  
1977 in respect of PCT application  
PCT/GB2014/050594 and EP patent application  
EP14715056.9

HEARING OFFICER

Phil Thorpe

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**DECISION**

**Introduction**

1. This decision relates to an uncontested request under section 12(1) in respect of PCT application PCT/GB2014/050594 and EP patent application EP14715056.9. Both applications currently name WallJam Limited as the sole applicant.
2. WallJam Limited and IEE International Electronics & Engineering S.A A jointly initiated proceedings under section 12(1)(a) on 2nd September 2015. In their amended statement of case they request that the comptroller confirms that pursuant to a joint development agreement WallJam Limited and IEE International Electronics & Engineering S.A t are jointly entitled to PCT/GB2014/050594 and EP14715056.9.

**The law**

3. These proceedings have been brought under section 12(1)(a) of the Patents Act, which reads:

Section 12(1)

At any time before a patent is granted for an invention in pursuance of an application made under the law of any country other than the United Kingdom or under any treaty or international convention (whether or not that application has been made) -

any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) any such patent for that invention or has or would have any right in or under any such patent or an application for such a patent; or

...

and the comptroller shall determine the question so far as he is able to and may make such order as he thinks fit to give effect to the determination.

### **Claimants' arguments**

4. The Joint Development Agreement (JDA) between WallJam Limited and IEE International Electronics & Engineering S.A. came into effect on 4<sup>th</sup> February 2013 and remains in force. Article 6 of the JDA is entitled "Exploitation of Foreground" and includes the following:

6.2 In the event the Parties seek patent protection for an invention, which incorporates IEE's and WallJam's Foreground, the parties agree on the following Exploitation terms:

- i) Application IEE and WallJam will jointly apply for such patent.

...

- ii) Territory. The parties shall jointly decide in which countries patent applications for Foreground shall be applied for and ...

5. The claimants note that in accordance with section 6.2 of the JDA, UK patent application GB 1303715.5 was filed on 1<sup>st</sup> March 2013 naming WallJam Limited and IEE International Electronics & Engineering S.A. as joint applicants.
6. On 28<sup>th</sup> February 2014 PCT application PCT/GB2014/050594 was filed claiming priority from GB 1303715.5 however this named WallJam as the sole applicant. The resulting EP application, EP14715056.9, also names WallJam as the sole applicant.
7. The claimants contend that WallJam and IEE were in agreement that the PCT application should be filed and hence in accordance with section 6.2 it should have been filed in the name of WallJam and IEE as co-applicants. I have no reason to doubt this

### **Findings and Order**

8. I find that International Electronics & Engineering S.A. and WallJam Limited are jointly entitled to be granted a patent for the invention in PCT patent application PCT/GB2014/050594 and European patent application EP14715056.9.

9. I therefore order that PCT patent application PCT/GB2014/050594 and European patent application EP14715056.9 should proceed in name of IEE International Electronics & Engineering S.A. and WallJam Limited as joint applicants.

**Costs**

10. No request has been made as to costs and hence I make no such order.

**Appeal**

11. Any appeal must be lodged within 28 Days.

Phil Thorpe  
Deputy Director acting for the Comptroller